

RONALD A. UNDERWOOD et al.  
Application No. 09/512,742  
Page 5

### **REMARKS**

Claims 1-51 were previously cancelled. Claims 52-68 were previously added. Dependent claim 69 has been added. It is analogous to previous claim 61 and thus does not require any substantial amount of additional work on the part of the PTO to examine.

In the event the claims are not passed onto allowance by this Amendment and Response, Applicant requests that the finality of the previous office action be withdrawn based on the reasons set forth below.

### **REQUEST TO WITHDRAW FINALITY OF OFFICE ACTION**

According to MPEP § 706.07(a), "any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) ..." See also MPEP §§ 706.07(b), and 706.07 (h)VIII.

In this case, independent claims 60-68 were new and included in a Request for Continued Examination (RCE). These claims were rejected in the Office Action for the first time with a 103 rejection. A reference (U.S. Pat. No. 6,007,570) that had not been applied previously in the prosecution was used in this rejection. Applicant therefore submits that the finality of the rejection should be withdrawn as not being proper.

Based on the foregoing, Applicant respectfully requests that the finality of the Office Action be withdrawn.

### **35 USC §103:**

According to the Office Action Claims 60, 61, 63-65, 67, and 68 are rejected under 35 USC § 103(a) as being unpatentable over U.S. Pat. No. 5,458,596 to Lax et al. (Lax) in view of U.S. Pat. No. 6, 007, 570 to Sharkey et al (Sharkey).

Applicant respectfully requests withdrawal of this rejection in view of Applicant's comments below. First, the Office Action acknowledges that Lax fails to disclose an

RONALD A. UNDERWOOD et al.  
Application No. 09/512,742  
Page 6

opening in the annulus. Lax additionally fails to disclose an opening surgically created in the annulus as amended claim 60 recites.

The Office Action states that Sharkey discloses “for herniations to include such openings.” However, a complete review of Sharkey fails to indicate that herniations include surgically created openings as the amended claims recite. In contrast Sharkey describes fissures. Fissures are not identical to surgically created openings. Accordingly, no combination of the cited references suggests all claim limitations, a requirement for a *prima facie* case of obviousness.

Based on the foregoing reconsideration and withdrawal of the rejection is requested.

Allowable subject matter:

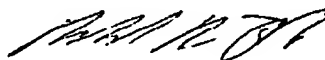
Applicant’s attorney wishes to express his gratitude to the Examiner for the indication of the allowable subject matter.

RONALD A. UNDERWOOD et al.  
Application No. 09/512,742  
Page 7

**IN CLOSING**

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (408) 735-6323.

Respectfully submitted,



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